

DAE \$ #17

PTO/SB/64 (10-01)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
CISCO-1261

First named inventor: Robert Charles Monsen et al.
Application No.: 09/414,995 Art Unit: 2155
Filed: October 7, 1999 Examiner: Won, Young N.
Title: METHOD AND APPARATUS FOR SECURING INFORMATION ACCESS

Attention: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

NOTE: If information or assistance is needed in completing this form, please contact Petitions
Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a
notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the
expiration date of the period set for reply in the Office notice or action plus an extensions of time
actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee --required for all utility and plant applications
filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee \$_____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1,330 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of Response to Office Action (identify type of reply):

- ☒ has been filed previously on March 14, 2002.
☒ is enclosed herewith.

B. The issue fee of \$_____

☐ has been paid previously on _____

☒ is enclosed herewith.

Adjustment date: 06/10/2004 AKELLEY
10/15/2003 SLUANG1 00000003 09414995
01 FC:1453
Repin. Ref: 06/10/2004 AKELLEY 0011014700
DAH:501698 Name/Number:09414995
FC: 9204 \$1330.00 CR

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 1.0 hour to complete. Time will vary depending upon the needs of the individual case. Any comments on
the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC
20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231

10/15/2003 SLUANG1 00000003 09414995

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3. Terminal disclaimer with disclaimer fee

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

PLEASE SEE ATTACHED STATEMENT "A"

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

10/5/03

Date



Signature

Telephone
Number: (408) - 292-5800

David B. Ritchie

Typed or printed name

P. O. Box 640640

Address

San Jose, CA 95164-0640

Enclosures: ☒ Fee Payment

☒ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

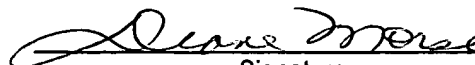
I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box 640640, Washington, DC 20064-0640, Mail Stop Petitions, P. O. Box 1450, Alexandria, VA 22313-01450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

10-7-03

Date



Signature

Diane Morse

Type or printed name of person signing certificate

Serial No. 09/414,995
Petition for Revival
Filed: October 6, 2003

CISCO-1261
032590-000072

STATEMENT "A"

An Office Action was mailed on January 10, 2003. Our response was timely filed on March 14, 2003 with a duly executed Certificate of Mailing. Apparently the filing was lost by either the United States Postal Service or the United States Patent and Trademark Office. The postcard receipt was never received by us. On September 9, 2003, Examiner Won called us to determine if we had filed a response. We told him that we had. On September 11, 2003, we faxed him a copy of the response. He later told us that we needed to file this Petition because we had not received the postcard receipt.

Accordingly, since this Petition is necessitated by factors entirely within the control of the United States Postal Service and/or United States Patent and Trademark Office, it is respectfully requested that the petition fee of \$1,330 be returned by crediting it back to our Deposit Account No. 50-1698.



Serial/Patent No.: 09/414,995

Filing/Issue Date: 10/7/99

Applicant: Monsen et al.

Title: Method and Apparatus for Securing Information Access

TRP Docket No.: CISCO-1261

Atty/Secty Initials: SJR/dm

Date Mailed: 3-14-03

Docket Due Date: 4/10/03

The following has been received in the U.S. Patent & Trademark Office on the date stamped hereon:

- | | |
|---|---|
| <input checked="" type="checkbox"/> Amendment/Response (6 pgs.) | <input type="checkbox"/> Drawings: _____ # of sheets includes _____ figures |
| <input type="checkbox"/> Appeal Brief (_____ pgs.) (in triplicate) | <input type="checkbox"/> IDS & PTO 1449 (_____ pgs.) |
| <input type="checkbox"/> Application - Utility (_____ pgs. with cover & abstract) | <input type="checkbox"/> _____ Pieces of Prior Art Enclosed |
| <input type="checkbox"/> Application - Rule 1.53(b) Continuation (_____ pgs.) | <input type="checkbox"/> Issue Fee Transmittal |
| <input type="checkbox"/> Application - Rule 1.53(b) Division (_____ pgs.) | <input type="checkbox"/> Submission of Formal Drawings:
_____ # of sheets includes _____ figures |
| <input type="checkbox"/> Application - Rule 1.53(b) CIP (_____ pgs.) | <input type="checkbox"/> Notice of Appeal |
| <input type="checkbox"/> Application - Rule 1.53(d) CPA (_____ pgs.) | <input checked="" type="checkbox"/> Postcard |
| <input type="checkbox"/> Application - PCT (_____ pgs.) | <input type="checkbox"/> Preliminary Amendment (_____ pgs.) |
| <input type="checkbox"/> Application - Provisional (_____ pgs.) | <input type="checkbox"/> Reply Brief (_____ pgs.) |
| <input type="checkbox"/> Assignment and Cover Sheet | <input type="checkbox"/> Req and Cert. Not to Publish - Rule 1.213 |
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| <input type="checkbox"/> Declaration & POA (_____ pgs.) | <input type="checkbox"/> Copy of PTO Notice to File Missing Parts |
| <input type="checkbox"/> Fee Transmittal | <input checked="" type="checkbox"/> Transmittal Letter (original & copy) |
| <input type="checkbox"/> Request for Continued Examination (RCE) (_____ pgs.) | <input type="checkbox"/> Express Mail No.: |
| <input type="checkbox"/> Other: | <input type="checkbox"/> Check(s) \$ |
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| | Patent Code: |
| | Client/Matter # 32590 - 72 |

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032590-72
Resp filed 3/14/03
sl 4/4/03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Robert Charles Monsen et al.
SERIAL NO.: 09/414,995
FILING DATE: October 7, 1999
TITLE: METHOD AND APPARATUS FOR SECURING
INFORMATION ACCESS
EXAMINER: Won, Young N.
ART UNIT: 2155

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Date: 3-14-03

Name:

Diane Morse
Diane Morse

**BOX NON-FEE AMENDMENT
COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231**

TRANSMITTAL LETTER

Enclosed for filing are the following documents:

1. Response to Office Action.


It is believed that no fee is required for filing the above-referenced documents. In
the event that any additional fee is required, including any fees required under 37 C.F.R.
§1.136 for any necessary extension of time to make the filing of the attached documents

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timely, the Commissioner is hereby authorized to charge any fees, and credit any overpayments, to Deposit Account No. 50-1698. A duplicate of this page is enclosed.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: 3/14, 2003



David B. Ritchie
Reg. No. 31,562

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P.O. Box 640640
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Fax: (408) 287-8040



COPY

et No. CISCO-1261

timely, the Commissioner is hereby authorized to charge any fees, and credit any overpayments, to Deposit Account No. 50-1698. A duplicate of this page is enclosed.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: 3/14, 2003

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CISCO-1261

#19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Robert Charles Monsen et al.
SERIAL NO.: 09/414,995
FILING DATE: October 7, 1999
TITLE: METHOD AND APPARATUS FOR SECURING
INFORMATION ACCESS
EXAMINER: Won, Young N.
ART UNIT: 2155

CERTIFICATE OF MAILING

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Date: 3-14-03

Name: *Diane Morse*
Diane Morse

RESPONSE TO OFFICE ACTION

BOX Non-Fee Amendment
COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Dear Sir:

This paper is in response to the Office Action dated January 10, 2003. Please consider the following.

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REMARKS

Claims 1-26 are pending in the present application with no claim allowed. Claims 1, 5, 9, 10, 13, 16, 19, and 23 are independent claims.

The 35 U.S.C. § 103 Rejection

Claims 1, 5, 9, and 23 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Orita* (US 5,163,147). This rejection is respectfully traversed.

Overall, except for the grounds for the rejection changing to § 103(a) from § 102(b) and the addition of a citation to column 3, lines 21-30, the rejection is identical to the rejection given in the Final Office Action dated September 27, 2002. There is no explicit rebuttal however to the discussion and arguments presented in the Preliminary Amendment dated November 21, 2002. It is uncertain how the form of the rejection and the minor new citation rebuts those arguments. The review of *Orita* that was presented in the Preliminary Amendment will not be repeated below as it must be assumed to be accurate by the fact that it was not rebutted. The arguments will be repeated and expanded below.

Generally, the Office Action states that *Orita* discloses or suggests all of the claim elements. However, each and every element as set forth in the present claims are not found in *Orita*. Furthermore, the various combinations of elements proposed by the Office Action are never arranged by *Orita* in the same manner as proposed by the Office Action or as required by the present claims. Specifically, several of the citations are duplicated, are only one line of disclosure, or are to the Summary of the Invention section. These citations do not fully explain or enable the disclosure of *Orita* or explain the basis of the rejection. Although it is possible for the Office Action to rely on what is "well known" as a basis for rejection, to be proper this must be taken as Official Notice and the modification of the cited reference must be fully explained and motivated in order to comply with M.P.E.P. § 2143. The modifications can not be assumed or implied, but must be explicit. In view of the above, the rejection fails to be *prima facie* and should be withdrawn.

The two part permission verification process is central to the disclosure of *Orita*. The Office Action overlooks the two part process by selectively focusing only on the second part. The second part depends on the first part and is not distinct from it. To ignore the first part is to change the principle of operation of *Orita* which is not allowed. (See M.P.E.P. § 2143.01.) Further, the rejection proposes to incorrectly combine the second part of the verification process of steps S12-S15 with the logon operation of steps S1-S5. These are two different processes that do not work together as proposed but work in series. (See FIG. 2 and col. 3, lines 10-32, among others.) Further still, *Orita* only discloses "comparing" the access type. (Col.4, line 61) The access protection information 12a is set by some other process prior to operation of the system and is never changed. It is not sufficient to argue that *Orita* could change the information if he never discloses that he actually does. The static nature of the access protection information is contrary to the present claims 1, 5, 9, and 23 where, as variously claimed, the active file security status is "changeable" from a first type to a second type and the active file security status is actually "changed" from the first type to the second type. The rejection is not as disclosed or claimed and should be withdrawn.

Given the above, *Orita* can not be said to render the present claims obvious.

Claims 10-21 stand rejected under 35 U.S.C. § 103(a) as being allegedly anticipated by *Scott et al.* (US 5,987,123) in view of *Orita* (US 5,163,147) and *Mandalia* (US 6,324,584 B1). This rejection is respectfully traversed.

Overall, the strong reliance of the rejection on *Scott* is substantially identical to the rejection given in the Final Office Action dated September 27, 2002. As above, there is no explicit rebuttal however to the discussion and arguments presented in the Preliminary Amendment dated November 21, 2002. It is uncertain how the new rejection completely rebuts those arguments. A review of *Scott* will be presented here for the first time. The pertinent arguments will be repeated and expanded below.

Generally, the Office Action states that *Scott* discloses or suggests most of the claim elements and that *Orita* and *Mandalia* disclose or suggest the rest of the claim elements.

For discussion purposes, a review of *Scott* will first be presented. The *Scott* patent is entitled a Secure File System with the emphasis on trust or verification and not access. *Scott* laments in the background section that "[c]omputer programs and computer data files are normally stored on computer systems without the capability of automatically sensing that programs and data are 1) authentic and 2) unmolested." (Col. 1, lines 22-25) It is these two aspects that *Scott* endeavors to "secure" with his invention. The disclosure must be interpreted in this light. This is important as this form of trust security differs from access security. Trust security wants to know where a file originated and that it is unaltered since it was created. Trust security does not deny access to the file once created. It does not even deny the ability of a non-originating user to alter the file, but it will make note of any alterations for future users to consider. The situation may be that the non-originating user is also acceptable to the future user. Further, trust security does not deny a user the ability to create a file, but it will carefully note which user it was that created the file by assigning each user a unique signature and encrypting it in the file. In this way, future users can check where the file originated. Conversely, access security will deny an unauthorized user the ability to see, alter, or create a file.

As noted previously and elaborated upon above, *Scott* is directed to providing "...a truly automatic and transparent method of checking and authenticating software and data in a computer system." (Col. 1, lines 30-31) That is to say that *Scott* wants the user to be "secure" in the knowledge that the software or data are trustworthy. This is a different sense of the term secure where trust security and access security are not the same. *Scott* is directed toward the former and the claims are directed toward the latter, therefore *Scott* cannot disclose or suggest the latter. Further, the rejection proposes to incorrectly combine the process of creating signed files of FIG. 5 with the verification of those files of FIG. 4. These are two different processes that do not work together as proposed but work in series, that is, there must first be a file before it can be verified. Further still, there is no disclosure by *Scott* of limitations on which users can

create signed files so long as they have a private key. Private keys may simply be issued upon demand of the user. The private keys are to distinguish one user from another. Protecting the private keys is for the user's benefit and not the system's benefit. Just because the private keys are unique does not mean that they are limited in number or application. The use of the term private key by *Scott* does not imply any "authorization" as claimed. Everyone may be authorized as no check is performed in the description of FIG. 5 of *Scott*. The rejection is not as disclosed or claimed and should be withdrawn.

With respect to *Orita* and *Mandalia*, the Office Action provides two small citations to the Summary and Background sections, respectively. These citations do not fully explain or enable the disclosures of *Orita* and *Mandalia* or explain the basis of the rejection. To be proper the modification of the cited references must be fully explained and motivated in order to comply with M.P.E.P. § 2143. The modifications can not be assumed or implied, but must be explicit. In view of the above, the rejection fails to be *prima facie* and should be withdrawn.

Given the above, the cited references can not be said to render the present claims obvious.

Claims 2, 6, 22, and 24 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Orita* (US 5,163,147) in view of *Subramaniam et al.* (US 5,519,507). Claims 3, 4, 7, 8, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Orita* (US 5,163,147) and *Subramaniam et al.* (US 5,519,507) in view of *Testin et al.* (US 4,776,038). These rejections are respectfully traversed.

Generally, the Office Action states that *Orita* discloses or suggests most of the claim elements and that *Subramaniam* and *Testin* disclose or suggest the rest of the claim elements. However, the arguments presented above with respect to *Orita* alone apply equally here. The addition of *Subramaniam* and *Testin* does nothing to refute those arguments. Thus the cited references can not be said to render the present claims obvious.

In view of the above, it is respectfully asserted that the claims are now in condition for allowance.

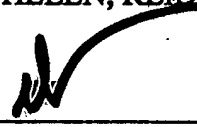
Request for Allowance

In view of the foregoing, reconsideration and an early allowance of this application are earnestly solicited.

If any matters remain which could be resolved in a telephone interview between the Examiner and the undersigned, the Examiner is invited to call the undersigned to expedite resolution of any such matters.

Respectfully submitted,
THELEN, REID & PRIEST LLP

Dated: March 14, 2003



David B. Ritchie
Reg. No. 31,562

Thelen, Reid, & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800

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REQUEST FOR PATENT FEE REFUND				
1 Date of Request: <u>6/9/04</u>		2 Serial/Patent # <u>09/414,995</u>		
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